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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,984	06/30/2008	Klaus-W. Voss	RW-186PCT	2772
40570	7590	09/23/2011	EXAMINER	
LUCAS & MERCANTI, LLP			COOLEY, CHARLES E	
475 Park Avenue South, 15th Floor				
New York, NY 10016			ART UNIT	PAPER NUMBER
			1774	
			NOTIFICATION DATE	DELIVERY MODE
			09/23/2011	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

INFO@LMIPLAW.COM

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/586,984	VOSS, KLAUS-W.
	<b>Examiner</b>	<b>Art Unit</b>
	CHARLES E. COOLEY	1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 21 July 2006.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 5) Claim(s) 1-32 is/are pending in the application.
  - 5a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 6) Claim(s) \_\_\_\_\_ is/are allowed.
- 7) Claim(s) 1-32 is/are rejected.
- 8) Claim(s) \_\_\_\_\_ is/are objected to.
- 9) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 10) The specification is objected to by the Examiner.
- 11) The drawing(s) filed on 05 June 2008 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/30/2008</u> .                                              | 6) <input type="checkbox"/> Other: _____ .                        |

## **NON-FINAL OFFICE ACTION**

- 1. This application has been assigned to Technology Center 1700, Art Unit 1774 and the following will apply for this application:**

Please direct all written correspondence with the correct application serial number for this application to **Art Unit 1774**.

Telephone inquiries regarding this application should be directed to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197 or to the Examiner at (571) 272-1139. All official facsimiles should be transmitted to the centralized fax receiving number 571-273-8300.

### ***Priority***

- 2. Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d). Both of the CERTIFIED copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).**

### ***Information Disclosure Statement***

- 3. Note the attached PTO-1449 form submitted with the Information Disclosure Statement filed 30 JUN 2008.**

### ***Drawings***

- 4. Applicant should verify that (1) all reference characters in the drawings are described in the detailed description portion of the specification and (2) all reference**

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characters mentioned in the specification are included in the appropriate drawing Figure(s) as required by 37 CFR 1.84(p)(5).

### **INFORMATION ON HOW TO EFFECT DRAWING CHANGES, IF NEEDED**

#### **Replacement Drawing Sheets**

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment. Any replacement drawing sheet must be identified in the top margin as "Replacement Sheet" (37 CFR 1.121(d)) and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin.

#### **Annotated Drawing Sheets**

A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be submitted or required by the examiner. The annotated drawing sheets must be clearly labeled as "Annotated Marked-up Drawings" and accompany the replacement sheets.

#### **Timing of Corrections**

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings MUST be filed within the THREE MONTH shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability.

***Specification***

5. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Appropriate correction is required.

6. The Abstract of the Disclosure is objected to because:

a. it lacks substance as it is not an adequate and clear statement of the contents of the disclosure. A reading of the abstract does not provide the character of the subject matter covered by the disclosure. Since the current abstract reads on the prior art, the abstract should be more comprehensive of the disclosed subject matter.

Correction is required. See MPEP § 608.01(b).

7. The title is acceptable.

***Claim Rejections - 35 U.S.C. § 112, second paragraph***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The second paragraph of 35 U.S.C. § 112 requires a claim to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Under *In re Hammack*, 427 F.2d 1378, 166 USPQ 204 (CCPA 1970) and *In re Moore*, 169 USPQ 236 (CCPA 1971), claims must be analyzed to determine their metes and bounds so that it is clear from the claim language what subject matter the claims encompass. This analysis must be performed in light of the applicable prior art and the disclosure. The definiteness of the claims is important to allow others who wish to enter the market place to ascertain the boundaries of protection that are provided by the claims. *Ex parte Kristensen*, 10 USPQ 2d 1701, 1703 (BPAI 1989).

One of the purposes of 35 U.S.C. § 112, second paragraph, “is to provide those who would endeavor, in future enterprise, to approach the area circumscribed by the claims of a patent, with adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance.” *In re Hammack*, supra. As set forth in *Amgen Inc. v. Chugai Pharmaceutical Co., Ltd.*, 927 F.2d 1200, 1217, 18 USPQ2d 1016, 1030 (Fed. Cir. 1991).

The statute requires that “[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” A decision as to whether a claim is invalid under this provision requires a determination whether those skilled in the art would understand what is claimed. See *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 624, 225 USPQ 634, 641 (Fed. Cir. 1985) (claims must “reasonably apprise those skilled in the art” as to their scope and be “as precise as the subject matter permits.”).

10. The pending claims fail to particularly point out and distinctly claim the subject matter which applicant regards as the invention and are therefore of indeterminate scope for the following reasons:

11. Regarding the pending claims the phrase "in particular" and "preferably by" renders the claims indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

12. Regarding the dependent claims, the claims are replete with terms which lack antecedent basis due to improper dependency such as "the device for increasing the flowability", "the outer limiting wall", "the elements for bringing kinetic energy", "the planes of extension", "the pressure pistons", "the actuator", "the drive shaft", "the inner chamber wall and the outer chamber wall", "the first electric motor", "the supporting bearing", etc. rendering the scope of the claims indefinite. The preceding list is not all inclusive. All claim terms should have proper antecedent basis.

13. Each pending claim should be thoroughly reviewed such that these and any other informalities are corrected so the claims may particularly point out and distinctly claim the subject matter which applicant regards as the invention, as required by 35 U.S.C. § 112, second paragraph.

***Claim Rejections - 35 USC § 102***

14. The terms used in this respect are given their broadest reasonable interpretation in their ordinary usage in context as they would be understood by one of ordinary skill in the art, in light of the written description in the specification, including the drawings, without reading into the claim any disclosed limitation or particular embodiment. See,

e.g., *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004); *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000); *In re Morris*, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22 (Fed. Cir. 1989).

15. The Examiner interprets claims as broadly as reasonable in view of the specification, but does not read limitations from the specification into a claim. *Elekta Instr. S.A.v.O.U.R. Sci. Int'l, Inc.*, 214 F.3d 1302, 1307 (Fed. Cir. 2000). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. Inc. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**17. Claims 1, 4, 5, 9, 18, 19, and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Wagner et al. (US 6,244,740 B1).**

The patent to Wagner et al. discloses a blending device having store tanks/cartridge cylinders (col. 1, lines 5-10 and col. 3, lines 23-26) for the separate storage of the components and at least one mixing chamber 10 which is connected by separate supplying channels 16, 17 with the single store tanks whereby the mixing chamber has at least one delivery opening 11 for the material to be mixed and whereby a metering device (pistons in the cartridge cylinders) is provided for the delivery of the components from the store tanks through the mixing chamber to the delivery opening,

wherein the supply of the components to the mixing chamber takes place by means of control devices 19, 20, 21 in such a manner that the hardener component/catalyst is supplied to the mixing chamber 10 with a slight advance with respect to the binder/base component (col. 2, lines 32-42 and col. 3, lines 30-39); a store tank having a binder/base component placed in the store tank and that the device has a device placed before the mixing chamber (one of the vanes 14) for increasing the flowability of the binder/base component which is driven by drive shaft 15; wherein the elements 14 for bringing in kinetic energy can be placed in several levels spaced from each other in direction of the rotational axis of the motion of revolution by gaps (Fig. 1); wherein the drive shaft 15 is capable of being drivingly connected with a handwheel; wherein the drive shaft 15 is drivingly connected with at least one mixing element 13, 14 placed in the mixing chamber 10. The method of claim 31 is disclosed at (col. 2, lines 32-42 and col. 3, lines 30-39).

**18. Claims 1 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Muhlbauer et al. (US 6,499,630 B2) per the International Search Report, Form 210 of 23 MAY 2006 and the Written Opinion, Form 237 of 11 SEP 2007:**

X      |    US 6 499 630 B2 (MUHLBAUER WOLFGANG ET AL)  
          |    31 December 2002 (2002-12-31)                                  |    1,31

**The patent to Muhlbauer et al. discloses:**

A device for mixing a binding component and a curing component to obtain a pasty or liquid mixed product, wherein the device has reservoirs (1, 11) for separately storing the component, and a mixing chamber (17) which is connected to the individual reservoirs (1, 11) via separate supply channels (6, 15), wherein the mixing

—  
chamber has a discharge opening for the mixed product, and wherein a metering unit (3, 13) is provided for conveying the components from the reservoirs through the mixing chamber to the discharge opening, and wherein the device for the curing component has a reservoir (11) which is connected to the mixing chamber via a supply channel (15), wherein the binding component and the curing component are supplied to the mixing chamber by means of control units (30) in such a manner that the curing component is supplied to the mixing chamber slightly ahead of the binding component (see D1, figures 2,3,4,6,11 and column 1, lines 55-57).

With regard to claim 31:

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A method for mixing a binding component and a curing component with the use of a device according to claim 1, wherein the binding component and the curing component are supplied, with the intermediate connection of a mixing device (3, 13), to a mixing chamber (17) to which the curing component is supplied slightly ahead of the binding component (see D1, figures 2, 3, 4, 6, 11 and column 1, lines 55-57)

### ***Claim Rejections - 35 USC § 103***

19. To determine whether subject matter would have been obvious, "the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved .... Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented."

*Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966).

The Supreme Court has noted:

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.

*KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740-41 (2007). "Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." (Id. at 1742).

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**21. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner et al. (US 6,244,740 B1).**

Wagner et al. does not disclose two store tanks for one of the components and separate supplying channels. However, it has been held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced. Thus, to duplicate the one store tank and supplying channel for one of the components in Wagner et al. for the purpose of increasing the storage capacity of the one component and permitting the one component to flow into the mixing chamber from each store tank through a respective supplying channel is far from being a new or unexpected result and is therefore obvious to one skilled in the art. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

22. **Claims 3, 8, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muhlbauer et al. (US 6,499,630 B2) in view of DE 20307518 U1 per the International Search Report, Form 210 of 23 MAY 2006 and the Written Opinion, Form 237 of 11 SEP 2007:**

DE 203 07 518 U1 (VOSSCHEMIE GMBH) 7 August 2003 (2003-08-07) cited in the application page 2 - page 3; figures 16,36	3,8,12
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\* \* \*

23. While the examiner might speculate as to what is meant by the language of indefinite claims 6-7, 10-11, 13-17, 20-30, and 32, the uncertainty provides the examiner with no proper basis for making the comparison between that which is claimed and the prior art (MPEP 2173.06). Rejections under 35 U.S.C. 103 should not be based upon "considerable speculation as to the meaning of terms employed and assumptions as to the scope of the claims." *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962). When no reasonably definite meaning can be ascribed to certain terms in a claim, the subject matter does not become obvious, but rather the claim becomes indefinite. *In re Wilson*, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). As it has been held that it is improper to rely on what are at best speculative assumptions as to the meaning of a claim and then base a rejection under 35 U.S.C. 103 thereon, no such rejections have been made concerning these claims. *Ex parte Brummer*, 12 USPQ2d 1654. However,

the lack of such rejections should not be construed as meaning that the claims as presently drawn would be patentable if corrected. Any response should carefully consider the prior art of record in accordance with 37 CFR 1.111.

***Conclusion***

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles E. Cooley in Art Unit 1774 whose telephone number is (571) 272-1139. The examiner can normally be reached on Monday - Friday. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
26. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Additional assistance can be obtained via the Ombudsman Pilot Program is designed to enhance the USPTO's ability to assist applicants and/or their representatives with issues that arise during patent application prosecution. More specifically, if there is a breakdown in the normal

prosecution process, the Ombudsman Pilot Program can assist in getting the process back on track. See <http://www.uspto.gov/patents/ombudsman.jsp> . If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Charles E. Cooley/

Charles E. Cooley  
Primary Examiner  
Art Unit 1774

18 September 2011